



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,720	09/25/2003	Steven James Randles	090128-0306004	6445

43569 7590 06/28/2005

MAYER, BROWN, ROWE & MAW LLP
1909 K STREET, N.W.
WASHINGTON, DC 20006

EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
----------	--------------

1764

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/669,720

Applicant(s)

RANDES ET AL.

Examiner

Ellen M. McAvoy

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 25 Sept. 2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Rejections - 35 USC § 112/101

Claim 25 provides for the use of a lubricant composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 25 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-24, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tolfa et al (6,127,324).

Tolfa et al ["Tolfa"] disclose a lubricating composition that is useful when operating a positive displacement compressor, such as a reciprocating rotary vane, scroll, or rotary screw air compressor, which comprises a blend of (A) at least one polyalkylene glycol and (B) at least one

alkyl aromatic compound. The polyalkylene glycol is represented by the formula in column 2, line 25, wherein alkylene oxides having from 2 to about 12 carbon atoms, especially ethylene oxide and propylene oxide, may be polymerized to form copolymers. Tolfa teaches that an alcohol initiator may be used to start the polymerization reaction. See column 2, line 25 to column 3, line 12. Tolfa teaches that blends of components (A) and (B) may be formed including about 95% to 5% of the polyalkylene glycols and about 5 to 95% of the alkyl aromatic. See column 3, lines 50-60. Tolfa allows for the addition of conventional lubricant additives to the composition including antioxidants, rust and corrosion inhibitors, metal deactivators and anti-wear agents. Tolfa teaches that the additives are used for their known purposes and comprise from about 10% to about 0.01% by weight of the lubricant composition, preferably from about 5% to about 0.001% by weight. See column 5, line 36 to column 6, top. Suitable additives include tricresyl phosphate antiwear agent; phenolic and amine antioxidants; sulfonate and polycarboxylic acid rust and corrosion inhibitors; and benzotriazole metal deactivators. Tolfa teaches that the lubricating compositions have a viscosity in the range of about 10 to about 150 cSt at 40°C, and a pour point in the range of about -10°C to about -100°C. See column 7, lines 12-20. The examiner is of the position that the lubricating oil compositions set forth in Tolfa meet the limitations of the above rejected composition and method claims. Applicants' open-ended claim language "comprising" allows for the addition of other additives to the compositions such as the alkyl aromatic compound, component (B), of the prior art. Applicants' invention differs by specifying that the polyalkylene glycol base oil contains ethylene oxide (EO) and propylene oxide (PO) in a EO:PO ratio of between 3:1 and 1:3 which is not specifically set forth

in Tolfa. However, in the formula of the polyalkylene glycol in column 2, line 25, the groups CHR_1 and CHR_2 which represent ethylene oxide and propylene oxide are in a 1:1 ratio which meets the claim limitations.

Claim Rejections - 35 USC § 103

Claims 1-24, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peeters (5,957,676) in combination with Tolfa et al (6,127,324).

Peeters discloses a rotary compressor using a liquid based on polyalkylene glycols which is miscible with water as a liquid lubricant for the bearings. Peeters teaches that copolymers of ethylene oxide and propylene oxide containing at least 40 mol% ethylene ether groups may be used. Such polyalkylene glycols contain about 50 mol % ethylene oxide and 50 mol % propylene oxide. See column 4, lines 63-67. Peeters teaches that by the addition of antioxidants, such as stearyl hindered phenol or phenacetin, the thermal stability of the lubricant can be increased. See column 5, lines 55-57. Applicants' invention differs by adding additional conventional additives to the composition including an antiwear agent and metal passivators. However, as evidenced by Tolfa, such additives are conventional for use in compressor lubricants which contain polyalkylene glycol as the base lubricant.

Tolfa is relied on as outlined above. Having the prior art references before the inventors at the time the invention was made it would have been obvious to have added the antiwear agent, metal passivator and anticorrosion agents of Tolfa to the composition of Peeters if their known imparted properties were so desired. The examiner recognizes that obviousness can only be

Art Unit: 1764

established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation relied on by the examiner is the knowledge generally available to one of ordinary skill that the addition of known lubricant additives together in one lubricant composition for their known imparted properties is obvious. See *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

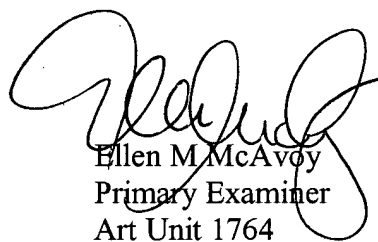
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 1764

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ellen M. McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
June 23, 2005